REMARKS

This is a full and timely response to the non-final Official Action mailed **May 27, 2009** (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 1-14 were cancelled previously without prejudice or disclaimer. By the forgoing amendment, the specification and claims 15-34 have been amended. Additionally, new claims 35-38 have been added. Thus, claims 15-38 are currently pending for further action.

Objection to Specification:

In the outstanding Office Action, the Examiner objected to the specification because of an informality. This issue has been corrected by the present amendment. Additionally, the specification has been carefully reviewed for grammatical and idiomatic accuracy. Appropriate corrections have been made. No new matter has been added.

Information Disclosure Statement:

The recent Office Action objected to the inclusion of several citations in the specification. Although Applicant is not required to submit an IDS, the Office Action points out that a list of references that an applicant wishes to be considered may not be incorporated into the specification, but must be submitted in a separate paper. These various citations will be addressed as follows:

1.   The Office Action points out that the specification contains a reference to "Embedding XMP Metadata in Application files", June 2002, Adobe Systems Incorporated, 345 Park Avenue, San Jose, Calif. 95110-2704, USA. In order to have this reference considered by the Office, Applicant respectfully submits along with this response, an IDS citing to this reference for the Examiner's review.

2.   The Office Action further suggests that the web address www.anoto.com found on page 1, line 28 should also be included in an IDS. Applicant wishes to point out that this website was included in the specification to give background information regarding the use of the Anoto AB system in analyzing pen markings via character recognition tools and storing those analyzed pen markings digitally as text. The Office Action points out that this citation was included in form PTO-892, page 1, Reference X. Applicant agrees.

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claims 15, 16, 32, and 33 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments. These various claims will be addressed as follows:

1.   Claim 15: In the recent Office Action, the Examiner points out that claim 15 contains the phrase "such as," rendering "the claim indefinite because it is unclear whether the limitations following the phrase are past of the claimed invention. See MPEP § 2173.05(d)." (Action, p. 5). While applicant does not necessarily agree that claim 15 was indefinite as filed, claim 15 has been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, claim 15 is

believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

2.   Claim 16: In the recent Office Action, the Examiner asserts that claim 16 contains the phrase "such as," rendering "the claim indefinite because it is unclear whether the limitations following the phrase are past of the claimed invention. See MPEP § 2173.05(d)." This issue is rendered moot by the amendment to claim 15, from which claim 16 depends, discussed above.

3.   Claim 32: The recent Office Action states that the phrases "content receiving means for" and "data structure means for" comingle "structure and function together while attempting to invoke means-plus function language . . . ." (Action, pp. 5-6). While applicant does not necessarily agree that claim 32 was indefinite as filed in view of § 112, paragraphs two and six, claim 32 has been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, sixth paragraph. Specifically, the above-referenced phrases have been amended to delete "content receiving" and "pattern receiving" portions of the above-referenced phrases.

The Office Action states that "it is unclear specifically which embodiment or elements the Applicant is necessarily and always referring to." (Action, p. 6). Applicant respectfully disagrees. Applicant believes that one of skill in the art would readily understand the scope of the means-plus-function claims and exemplary embodiments thereof from the disclosure in Applicant's specification Therefore, following this amendment, claim 32 is believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

4.   Claim 33: In the recent Office Action, the Examiner points out that claim 33 also contains the phrase "such as," rendering "the claim indefinite because it is unclear whether the limitations following the phrase are past of the claimed invention. See MPEP § 2173.05(d)." (Action, p. 5). While applicant does not necessarily agree that claim 33 was indefinite as filed, claim 33 has been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, claim 33 is believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Rejections under 35 U.S.C. §101:

In the recent Office Action, claims 15-34 were rejected under 35 U.S.C. § 101. These claims have been carefully reviewed in light of the Examiner's comments and Applicants analysis of the individual independent claims is as follows:

Claim 15:

With regard to claim 15, specifically, the Office Action states, "[c]laim 15 is directed to a data structure which defines an electronic document," but fails to provide a means to overcome the rejection of claim 15 due to an omission in the Office Action. (Action, p. 6). Applicant assumes that the Examiner is rejecting claim 15 because it is directed to non-statutory subject matter; namely, a "data structure."

Claim 15 now recites:

> A computer program product for generating an electronic document,
> the computer program product comprising:
>   a computer usable medium having computer usable program code
> embodied therewith, the computer usable program code comprising:

computer usable program code configured to define the electronic document;

in which the computer usable program code comprises first and second portions of data;

in which the first portion of data defines the content of the electronic document and the second portion comprises data relating to a pattern of position identification markings such that, when the electronic document is printed, a pattern reading device is able to determine its position relative to the position identification markings; and

in which the computer usable program code comprises a single data file with the first and second data portions being embedded within the data file.

Support for the amendment to claim 15 can be found in Applicant's originally filed specification at, for example, page 2, line 16 through page 6, line 21, page 8, lines 15-17, and page 14, line 28 through page 15, line 2.

Therefore, claim 15 is now direct to an article of manufacture; namely, a computer program product. This is clearly statutory subject matter under 35 U.S.C. § 101. Following this amendment, claim 15 is believed to be in compliance with 35 U.S.C. § 101 and notice to that effect is respectfully requested.

Claim 32:

With regard to claim 32, the Office Action states that claim 32 is directed to non-statutory subject matter because it recites an application, and that the specification refers to application files as functional descriptive matter or software per se. (Action, p. 7).

However, claim 32 now recites:

A system for producing an electronic document, the system comprising:
means for receiving the content of the electronic document,
means for receiving data defining a pattern of positional markings allocated to at least a portion of the document; and
means for generating a data structure defining the electronic document which data structure comprises first and second portions of data, the first

portion of data defining the content and the second portion of data relating to the pattern.

Support for the amendment to claim 32 can be found in Applicant's originally filed specification at, for example, page 7, line 9 through page 8, line 8.

Therefore, claim 32 is now direct to statutory subject matter under 35 U.S.C. § 101; namely, a system. Following this amendment, claim 32 is believed to be in compliance with 35 U.S.C. § 101 and notice to that effect is respectfully requested.

Prior Art: Rejections under 35 U.S.C. §102(b):

In the recent Office Action, claims 15-22 and 32-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,065,021 to George (hereinafter "George"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 15:

Claim 15 recites:

> A computer program product for generating an electronic document, the computer program product comprising:
> a computer usable medium having computer usable program code embodied therewith, the computer usable program code comprising:
> computer usable program code configured to define the electronic document;
> in which the computer usable program code comprises *first and second portions of data*;
> in which *the first portion of data defines the content of the electronic document* and *the second portion comprises data relating to a pattern of position identification markings* such that, when the electronic document is printed, *a pattern reading device is able to determine its position relative to the position identification markings*; and
> in which the computer usable program code comprises a single data file with the first and second data portions being embedded within the data file.

(Emphasis added).

As stated above, support for the amendment to claim 15 can be found in Applicant's originally filed specification at, for example, page 2, line 16 through page 6, line 21, page 8, lines 15-17, and page 14, line 28 through page 15, line 2.

In contrast, George does not teach or suggest a computer program product for generating an electronic document, the computer program product comprising a computer usable medium having computer usable program code embodied therewith, the computer usable program code comprising computer usable program code configured to define the electronic document in which the computer usable program code comprises first and second portions of data, in which the first portion of data defines the content of the electronic document and the second portion comprises data relating to a pattern of position identification markings such that, when the electronic document is printed, a pattern reading device is able to determine its position relative to the position identification markings, and in which the computer usable program code comprises a single data file with the first and second data portions being embedded within the data file.

Generally, George teaches "methods and apparatus for rapid alignment of graphical elements in electronic documents." (George, col. 1, ll. 7-9). More specifically, George teaches the use of a "control string [which] defines those types of alignments that should be considered and an ordering of the alignment types" within a drawing application or program. (George, col. 3, ll. 38-39, and Fig. 1b). "The control string is of the form of a series of groups, with each group including one or more types of alignments . . . , and may "include groups 92, 94 and 96. First group 92 includes two alignment types 98-1 and 98-2, while group 94 and 96 include only one alignment type 98-3 and 98-4, respectively." (George, col. 3, ll. 42-58, and Fig. 1b). In other words, George teaches a computer drawing application or

program that includes an alignment function that performs the alignment of graphical elements in electronic documents.

In rejecting claim 15, the Office Action asserts that the various groups in the control string of George are the first and second portions of data of claim 15. (Action, p. 8). However, this is incorrect. The groups within the control string of George are simply used to define types of alignments among various objects and elements in an electronic document.

In contrast, claim 15 recites computer usable program code configured to define the electronic document in which the computer usable program code comprises first and second portions of data, and in which the first portion of data defines the content of the electronic document and the second portion comprises data relating to a pattern of position identification markings. This subject matter is clearly not taught or suggested by George.

Finally, George does not teach or suggest that, when the electronic document is printed, a pattern reading device is able to determine its position relative to the position identification markings. Previous to the present amendment, claim 15 recited "a pattern reading device, such as a pen." The phrase "such as a pen" has been deleted. However, the phrase "a pattern reading device" remains. On this point, the Office Action states that George teaches a "pen."

However, it is clear from George that this recitation of a pen cannot be construed as a pattern reading device. Specifically, George teaches a drawing tool that is "used to draw objects in [an] electronic document," and that such a "drawing tool may include a pen tool, which may be used to draw lines and curves." (George, col. 2, ll. 51-56). George does not teach or suggest that the drawing tool may be configured to read a pattern.

In contrast, claim 15 recites that, when the electronic document is printed, a pattern

reading device is able to determine its position relative to the position identification markings.

This subject matter is also clearly not taught or suggested by George.

Respectfully, to anticipate a claim, a reference must teach each and every element of

the claim, and "the identical invention must be shown *in as complete detail as contained in*

the ... claim." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d

628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9

USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in

order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim

within the four corners of the document, but must also disclose those elements 'arranged as in

the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck &*

Co., 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the

rejection based on George of claim 15 and its dependent claims should be reconsidered and

withdrawn.

Claim 32:

Claim 32 recites:

> A system for producing an electronic document, the system
> comprising:
> > *means for receiving the content of the electronic document*,
> > *means for receiving data defining a pattern of positional markings*
> > *allocated to at least a portion of the document*; and
> > means for generating a data structure defining the electronic document
> > which data structure comprises *first and second portions of data, the first*
> > *portion of data defining the content and the second portion of data relating*
> > *to the pattern*.

(Emphasis added).

Support for the amendment to claim 32 can be found in Applicant's originally filed specification at, for example, page 7, line 9 through page 8, line 8.

In contrast, George does not teach or suggest a system for producing an electronic document, the system comprising means for receiving the content of the electronic document, means for receiving data defining a pattern of positional markings allocated to at least a portion of the document, and means for generating a data structure defining the electronic document which data structure comprises first and second portions of data, the first portion of data defining the content and the second portion of data relating to the pattern. As stated above, George simply teaches "methods and apparatus for rapid alignment of graphical elements in electronic documents." (George, col. 1, ll. 7-9). More specifically, George teaches the use of a "control string [which] defines those types of alignments that should be considered and an ordering of the alignment types" within a drawing application as discussed above in connection with claim 15. (George, col. 3, ll. 38-39, and Fig. 1b). In other words, George teaches a computer drawing application or program that includes an alignment function that performs the alignment of graphical elements in electronic documents.

In rejecting claim 32, the Office Action asserts that the various groups in the control string of George are the means for receiving the content of the electronic document. (Action, p. 10). However, this is incorrect. The groups within the control string of George are simply used to define types of alignments that may be applied to objects or other elements in an electronic document, and do not function to *receive* content of an electronic document.

In contrast, claim 32 recites a system for producing an electronic document, the system comprising means for receiving the content of the electronic document. This subject matter is clearly not taught or suggested by George.

Further, George does not teach or suggest a system for producing an electronic

document, the system comprising means for receiving data defining a pattern of positional

markings allocated to at least a portion of the document. The Office Action cites to the

following portion of George:

> Referring back to FIG. 2, the application may include ***tools for defining a grid
> 109 of horizontal and vertical lines*** 110 for application to a electronic
> document ***similar to graph paper***. As with graph paper, the lines may be
> other than horizontal and vertical while still producing a grid. ***Grid line
> engine 78 (FIG. 1a) determines the position of each such grid line and
> evaluates the grid lines as candidates for alignment.*** Grid line engine 78
> (FIG. 1a) receives as inputs radius information and the current cursor location.
> ***The grid line engine produces as an output a list of all possible alignments
> to the grid lines of the electronic document and an alignment point (or
> curve) for the proposed alignment.***

(George, col. 6, ll. 27-50)(emphasis added).

In other words, George simply teaches a grid line engine that determines possible alignment

candidates for aligning objects or other elements in an electronic document, and provides a

list of those possible alignments for a proposed alignment of the objects or other elements. In

clarifying the function of the grid lines in George, Applicant wishes to point out that the grid

lines are not a pattern of positional markings, but only serve as candidates for alignment of

objects in a computer drawing application or program. Therefore, although the grid line

engine of George provides a grid within an electronic document, George does not teach that

the grid line engine also provides data defining a ***pattern of positional markings***.

In contrast, claim 32 recites a system for producing an electronic document, the

system comprising means for receiving data defining a pattern of positional markings

allocated to at least a portion of the document. This subject matter is also clearly not taught

or suggested by George.

Finally, George does not teach or suggest a system for producing an electronic

document, the system comprising means for generating a data structure defining the electronic

document which data structure comprises first and second portions of data, the first portion of data defining the content and the second portion of data relating to the pattern. As discussed above, George simply teaches "methods and apparatus for rapid alignment of graphical elements in electronic documents," and, more specifically, George teaches the use of a "control string [which] defines those types of alignments that should be considered and an ordering of the alignment types" within a drawing application or program. (George, col. 1, ll. 7-9, col. 3, ll. 38-39, and Fig. 1b). In other words, George teaches a computer drawing application or program that includes an alignment function that performs the alignment of graphical elements in electronic documents.

In rejecting claim 32, the Office Action asserts that the various groups in the control string of George are the first and second portions of data of claim 32. (Action, p. 8). However, this is incorrect. The groups within the control string of George are simply used to define types of alignments among various objects and elements in an electronic document.

In contrast, claim 32 recites a system for producing an electronic document, the system comprising means for generating a data structure defining the electronic document which data structure comprises first and second portions of data, the first portion of data defining the content and the second portion of data relating to the pattern. This subject matter is clearly not taught or suggested by George.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim

within the four corners of the document, but must also disclose those elements 'arranged as in

the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck &*

Co., 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the

rejection based on George of claim 32 should be reconsidered and withdrawn.

Claim 33:

Claim 33 recites:

A method for generating an electronic document comprising creating an
electronic file and ***storing in that file data and metadata***, the ***data defining at
least some content and the metadata relating to a pattern of position
identification markings arranged to allow a pattern reading device to
determine its position within the position identification markings***, the
electronic file capable of generating an electronic document.
(Emphasis added).

Support for the amendment to claim 33 can be found in Applicant's originally filed

specification at, for example, page11, lines 9-27 and Fig. 3.

In contrast, George does not teach or suggest a method for generating an electronic

document comprising creating an electronic file and storing in that file data and metadata, the

data defining at least some content and the metadata relating to a pattern of position

identification markings arranged to allow a pattern reading device to determine its position

within the position identification markings, the electronic file capable of generating an

electronic document. As discussed above, George simply teaches "methods and apparatus for

rapid alignment of graphical elements in electronic documents." (George, col. 1, ll. 7-9, and

Fig. 1b). In other words, George teaches a computer drawing application or program that

includes an alignment function that performs the alignment of graphical elements in

electronic documents.

The Office Action asserts that George teaches a method for generating an electronic document comprising creating an electronic file and storing in that file data and metadata. (Action, p. 11). However, this is incorrect. George does not mention storing metadata in a file.

In contrast, claim 33 recites a method for generating an electronic document comprising creating an electronic file and storing in that file data *and metadata*. This subject matter is clearly not taught or suggested by George.

Further, George does not teach or suggest a method for generating an electronic document comprising creating an electronic file and storing in that file data and metadata, the data defining at least some content and the metadata relating to a pattern of position identification markings. As an initial matter, the Office Action does not cite to any portion of George in connection with the data and/or metadata of claim 33. (Action, p. 11). In this regard, the Office Action has failed to state a prima facie case of anticipation by not demonstrating that each and every element as set forth in claim 33 is found, either expressly or inherently described, in George.

Further, George does not teach or suggest the data and metadata, the data defining at least some content and *the metadata relating to a pattern of position identification markings* of claim 33. Other independent claims have been rejected based on the "control string" of George. George teaches the use of a "control string [which] defines those types of alignments that should be considered and an ordering of the alignment types" within a drawing application or program. (George, col. 3, ll. 38-39, and Fig. 1b). "The control string is of the form of a series of groups, with each group including one or more types of alignments . . . , and may "include groups 92, 94 and 96. First group 92 includes two alignment types 98-1 and 98-2, while group 94 and 96 include only one alignment type 98-3

and 98-4, respectively." (George, col. 3, ll. 42-58, and Fig. 1b). In other words, George teaches a computer drawing application or program that includes an alignment function that performs the alignment of graphical elements in electronic documents. However, as stated above, the groups within the control string of George are simply used to define types of alignments among various objects and elements in an electronic document.

In contrast, claim 33 recites a method for generating an electronic document comprising creating an electronic file and storing in that file data and metadata, the data defining at least some content and the metadata relating to a pattern of position identification markings. This subject matter is clearly not taught or suggested by George.

Still further, George does not teach or suggest metadata relating to a pattern of position identification markings arranged to allow a *pattern reading device* to determine its position within the position identification markings. Previous to the present amendment, claim 33 recited "a device, such as a pen." The phrase "such as a pen" has been deleted, and the phrase "pattern reading" has been added. Thus, claim 33 now contains the phrase "a pattern reading device." On this point, the Office Action states that George teaches a "pen."

However, it is clear from George that this recitation of a pen cannot be construed as a pattern reading device. Specifically, George teaches a drawing tool that is "used to draw objects in [an] electronic document," and that such a "drawing tool may include a pen tool, which may be used to draw lines and curves." (George, col. 2, ll. 51-56). George does not teach or suggest that the drawing tool may be configured to read a pattern.

In contrast, claim 33 recites a method for generating an electronic document comprising creating an electronic file and storing in that file data and metadata, the data defining at least some content and the metadata relating to a pattern of position identification markings. This subject matter is also clearly not taught or suggested by George.

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Finally, George does not teach or suggest a method for generating an electronic

document comprising creating an electronic file and storing in that file data and metadata, the

data defining at least some content and the metadata relating to *a pattern of position*

identification markings arranged to allow a pattern reading device to determine its position

within the position identification markings. The Office Action cites to the following portion

of George:

> Referring back to FIG. 2, the application may include *tools for defining a grid*
> *109 of horizontal and vertical lines* 110 for application to a electronic
> document *similar to graph paper*. As with graph paper, the lines may be
> other than horizontal and vertical while still producing a grid. *Grid line*
> *engine 78 (FIG. 1a) determines the position of each such grid line and*
> *evaluates the grid lines as candidates for alignment.* Grid line engine 78
> (FIG. 1a) receives as inputs radius information and the current cursor location.
> *The grid line engine produces as an output a list of all possible alignments*
> *to the grid lines of the electronic document and an alignment point (or*
> *curve) for the proposed alignment.*

(George, col. 6, ll. 27-50)(emphasis added).

In other words, George simply teaches a grid line engine that determines possible alignment

candidates for aligning objects or other elements in an electronic document, and provides a

list of those possible alignments for a proposed alignment of the objects or other elements. In

clarifying the function of the grid lines in George, Applicant wishes to point out that the grid

lines are not a pattern of positional markings, but only serve as candidates for alignment of

objects in a computer drawing application or program. Therefore, although the grid line

engine of George provides a grid within an electronic document, George does not teach that

the grid line engine also provides data defining a *pattern of positional markings*.

In contrast, claim 33 recites a method for generating an electronic document

comprising creating an electronic file and storing in that file data and metadata, the data

defining at least some content and the metadata relating to a pattern of position identification

markings arranged to allow a pattern reading device to determine its position within the

position identification markings. This subject matter is also clearly not taught or suggested by George.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the rejection based on George of claim 33 and its dependent claim should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 16:

Claim 16 recites: "[t]he computer program product of claim 15 which is written in such a form that the computer usable *program code can be converted from one format to other formats* without losing any of the information from the electronic document." (Emphasis added). In contrast, George does not teach or suggest a computer program product of claim 15 which is written in such a form that the computer usable program code can be

converted from one format to other formats without losing any of the information from the

electronic document.

The Office Action cites to the following portion of George in rejecting clam 16:

> ***The control string defines those types of alignments that should be***
> ***considered and an ordering of the alignment types.*** The set of possible
> alignments is tool dependent and a specific control string is associated with
> each tool. In one implementation, the control string is of the form of a series
> of groups, with each group including one or more types of alignments. Types
> of alignments include boundary, custom tool, construction line, grid line, page
> boundary and graphical object alignments. In the implementation each
> alignment type corresponds to a unique engine in the constraint system. The
> type information may be further refined to include ***format information***
> ***relating to the format of the particular alignment type*** requested. In the
> following example, three distinct ***formats*** are selectable ***including alignment***
> ***to single points, alignment to single lines or curves or alignment to the***
> ***intersection of two or more lines or curves.*** An example of a control string is
> shown in FIG. 1b.

(George, col. 3, ll. 38-53)(emphasis added).

In this instance, the term "format" as used in George refers only to the types of alignments

available via the computer application or program of George "including alignment to single

points, alignment to single lines or curves or alignment to the intersection of two or more

lines or curves." (George, col. 3, ll. 51-53). In other words, the word "format" is referring to

the format information relating to the format of the particular alignment type requested within

a graphics application (computer program).

In contrast, claim 16 recites the computer program product of claim 15 which is

written in such a form that the computer usable program code can be converted from one

format to other formats without losing any of the information from the electronic document.

This subject matter is also clearly not taught or suggested by George.

Finally, the Office Action further states that the recitation of claim 16 regarding

"without losing any of the information from the electronic document" is found in George via

a "***negative limitation met by the absence of the words*** 'loss', 'lost', 'losing', 'lossily' and

'lossy'." (Action, p. 9). However, simply because George does not contain these words does

not mean that George teaches the conservation of data during a format conversion process.

This is the very definition of lack of anticipation; wherein a prior art reference does not

contain one or more recitations within a claim. Therefore, with regard to the recitation of

"without losing any of the information from the electronic document," the Office Action has

not met its burden of demonstrating a prima facie case of anticipation.

Again, to anticipate a claim, a reference must teach each and every element of the

claim, and "the identical invention must be shown *in as complete detail as contained in the ...*

claim." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2

USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9

USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in

order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim

within the four corners of the document, but must also disclose those elements 'arranged as in

the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck &*

Co., 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the

rejection based on George of claim 16 and its dependent claims should be reconsidered and

withdrawn.

Claims 17 and 18:

Claim 17 recites: "[t]he computer program product of claim 15 in which the second

portion of data comprises metadata and in which the computer usable program code includes

one or more controls which control the way in which the second portion of data is

converted between formats to preserve the pattern." (Emphasis added). Claim 18 recites

similar claim language.

In contrast, George does not teach or suggest the computer program product of claim 15 in which the second portion of data comprises metadata and in which the computer usable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserve the pattern.

In rejecting claim 17, the Office Action cites to Figs. 7a and 7b of George. However, Figs. 7a and 7b of George simply teach methods of aligning objects within an electronic document, and basing those alignments on certain constraints within the graphics application. George does not teach or suggest that such an alignment process controls the way in which metadata is converted between formats to preserve the pattern of position identification markings.

In contrast, claim 17 recites the computer program product of claim 15 in which the second portion of data comprises metadata and in which the computer usable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserve the pattern. This subject matter is also clearly not taught or suggested by George.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the

rejection based on George of claim 17 and its dependent claims should be reconsidered and withdrawn.

Claims 19, 20, 21, and 22:

Claim 19 recites: "[t]he computer program product of claim 15 in which the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking." (Emphasis added). Claims 20, 21, and 22 contain similar recitations, but depend from different senior claims.

In contrast, George does not teach or suggest a computer program product in which the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking. The Office Action cites to Figs. 2, 7a, and 7b. However, Figure 2 and its accompanying disclosure within the specification of George simply details how "page boundaries 106 are defined by the edges of the page on which the document is to be printed and define the boundary of the imageable part of the page 108," and how a grid line engine determines the position of horizontal and vertical grid lines and determines which grid lines should be used in aligning objects within the electronic document within a drawing application or program. (George, col. 5, ll. 48-51, and col. 6, ll. 15-26). In other words, this portion of George does not teach data in a second portion that comprises data from which and algorithm can generate a pattern of position identification markings.

Further, Figures 7a and 7b and their accompanying disclosures within the specification of George simply detail how an alignment processor and constraint system of the computer program of George are used to align objects within the electronic document. (George, col. 8, l. 58 through col. 9, l. 65, and col. 10, ll. 7-54). In other words, this portion of George does not teach co-ordinates or other *metadata* identifying the portion of the position identification marking.

In contrast, claims 19, 20, 21, and 22 recite a computer program product in which the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking. This subject matter is also clearly not taught or suggested by George.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and "the identical invention must be shown *in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, "[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Therefore, for at least the reasons explained here, the rejection based on George of claim 19, 20, 21, and 22 and their dependent claims should be reconsidered and withdrawn.

Prior Art: Rejections under 35 U.S.C. §103(a):

(1)   In the recent Office Action, claims 23-30 and 34 were rejected under 35 U.S.C. §

103(a) as being unpatentable over George in view of U.S. Patent Application Publication No.

2003/0140311 to Lemon et al. (hereinafter "Lemon"). The rejection of claims 23-30 and 34

should be reconsidered and withdrawn for at least the same reasons given above in favor of

the patentability of independent claims 15 and 33.

(2)   In the recent Office Action, claim 31 was rejected under 35 U.S.C. § 103(a) as being

unpatentable over George in view of U.S. Patent Application Publication No. 2002/0099687

to Krishnaprasad et al. (hereinafter "Krishnaprasad"). The rejection of claim 31 should be

reconsidered and withdrawn for at least the same reasons given above in favor of the

patentability of independent claim 15.

Double Patenting:

        The recent Office Action provisionally rejects claims 15 on grounds of non-statutory,

obviousness-type double patenting over various claims of co-pending U.S. Patent Application

No. 10/571,076. Because this is a *provisional* rejection, Applicant is not required to make

any response at this time. However, Applicant notes that, given the amendments to the

claims included in the present paper, a double patenting rejection may no longer be thought

proper following entry of this amendment.

New Claims:

  The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. Therefore, examination and allowance of the newly added claims is respectfully requested.

Conclusion:

  In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

  The absence of a reply to a specific rejection, issue, or comment in the Office Action does not signify agreement with or concession of that rejection, issue, or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application

in better form, the Examiner is requested to telephone the undersigned attorney at the number

listed below.

Respectfully submitted,

DATE: August 27, 2009   __/Steven L. Nichols/_____
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